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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/750,837

12/28/2000

Rainer Loesch

2345/17A

1255

26646

7590

12/15/2003

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 12/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

cb7D

Office Action Summary

Application No.

09/750,837

Applicant(s)

LOESCH ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed September 22, 2003.

Claim 1 was amended rendering claims 1-5 are pending in this case.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saaski et al. (U.S. 4,778,987) in view of Forrest et al (U.S. 5,315,129) for reasons previously stated in the Office Action submitted on March 18, 2003. Regarding the newly added limitation to claim 1, 'using one of high resolution and ultrahigh-resolution imaging methods,' Saaski shows a measuring device providing a high degree of resolution in measuring physical parameters (column 1, lines 23-37).

Response to Arguments

4. Applicant's remarks to 35 USC 103(a) as being unpatentable over Saaski et al. (U.S. 4,778,987) in view of Forrest et al (U.S. 5,315,129) have been considered but are

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unpersuasive. Applicant argues Saaski does not teach a plurality of one of crystalline and amorphous first material layers and a plurality of crystalline and amorphous second material layers which are distinguishable from the first material layers when imaged using high-resolution or ultrahigh-resolution imaging methods, the second material layer having a second thickness and the first material layer alternating with the second material layer because Saaski does not disclose chrome being crystalline. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Although Saaski does not explicitly disclose chrome being crystalline, Forrest teaches measuring devices with alternating crystalline layers (abstract and column 1, line 64 through column 2, line 27). Applicant argues the purpose of the light absorbing coating of Saaski is to prevent external light from entering optically the structure through its cover and Forrest cannot cure the deficiencies of Saaski because Forrest concerns organic optoelectronic devices having alternating layers of two crystalline planar organic aromatic semiconductors. Applicant is arguing the intended use (purpose) of the Saaski and Forrest inventions. The intended use of the reference is of little relevance because intended use is given little patentable weight in product claims. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Applicant argues the Forrest reference does not appear to teach or suggest a plurality of one of crystalline and amorphous first material layers and a plurality of one of crystalline and

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amorphous second material layers distinguishable from the first material layers when imaged using high resolution or ultrahigh-resolution imaging methods. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, the Forrest reference does not have to teach crystalline and amorphous first and second material layers. In instant claim 1, the phrase, 'a plurality of one of crystalline and amorphous first material layers' is interpreted by the examiner as the first material layer comprising a plurality of either crystalline or amorphous material. This is due to the 'plurality of one of' claim language. This is also the case with a 'plurality of one of crystalline and amorphous second material layers'. Applicant argues the Fischer reference, alone or in combination with the Saaski reference, does not render obvious claim 1 under 35 USC 103(a). This argument is moot because the rejection of March 18, 2003, does not disclose a rejection using the Fischer reference. Applicant argues since claims 2 to 5 depend directly or indirectly from claim 1, claims 2 to 5 are allowable. Because claim 1 has been maintained as being unpatentable over the cited art, claims 2 to 5 are maintained as being rejected for reasons of record. Applicant argues not motivation or suggestion for combining the elements has been established. Examiner respectfully disagrees because the rejection disclosed It would have been obvious to one of ordinary skill to include an additional crystalline layer in the measuring

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device of Saaski because Forrest teaches the crystalline layer can be very thin and give enhanced properties (column 2, lines 1-27).

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the

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examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISOR, PATENT EXAMINER
TRIAL DIV CENTER 1700

